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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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17

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/132,156

Applicant(s)
Wittwer et al.

Examiner
Ardin Marschel

Art Unit
1631



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Jan 22, 2001

2a) This action is **FINAL**. 2b) ☒ This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 59-89 is/are pending in the applica

~~4) ☒ Of the above, Claim(s) 1-58 have been canceled. is/are withdrawn from consideration.~~

5) Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 59-89 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) ☐ Some* c) ☐ None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

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| *5) Notice of References Cited (PTO-892) | 18) Interview Summary (PTO-413) Paper No(s) _____ |
| *6) Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) Notice of Informal Patent Application (PTO-152) |
| *7) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) Other _____ |

The request, filed 1/22/01, for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/132,156 is acceptable and a CPA has been established. An action on the CPA follows.

Applicants' arguments, filed 1/22/01, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 59-89 are rejected, as discussed below, under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for amplification reactions performed in a capillary vessel or hollow elongate glass tubes, does not reasonably provide enablement for any generic reaction vessels or sample holding structure. Applicants have argued that the sample holder must be of low thermal mass, of which a capillary tube is an preferred embodiment only. Thus, some characteristic of the sample holder must permit rapid thermal cycling. Applicants have persuasively argued that any container will not do. Therefore, some limitation as to the sample holder which permits rapid thermal cycling is admitted by applicants. As presently worded the instant claims do not limit the sample container at all other than it holds sample. This scope is broader than the clear need

for sample containers which function similar, at least, to a capillary for rapid heat transfer. This is supported as previously stated by Wittwer et al.(1991) and Swerdlow et al.(1993) and has not been disagreed with in applicants arguments.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

April 20, 2001

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER